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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,770	01/30/2004	Hidehiko Ogawa	P24500	5547

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EXAMINER	
LEE, TOMMY D	
ART UNIT	**PAPER NUMBER**
2625	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/767,770	OGAWA, HIDEHIKO	
	Examiner	Art Unit	
	Thomas D. Lee	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/6/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office action is responsive to applicant's amendment, filed January 6, 2006. Claims 1-35 are pending.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,742,769 (Lee et al., hereinafter Lee) in view of U.S. Patent 5,878,230 (Weber et al., hereinafter Weber).

Regarding claims 1-5 and 11-15 and 34, Lee discloses an image data communication apparatus connected to an image data source and to a network, and transmitting an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message (column 7, lines 26-39), the image data communication apparatus comprising: a panel section configured to input a mail address of a user to the image data communication apparatus (in order to log in, a user enters the e-mail address and password for authentication (column 5, lines 7-15)), the user distinct from the image data communication apparatus (user and image data communication apparatus are two different entities, and thus are inherently "distinct"); and a controller configured to set the mail address of the user, input by the panel section, into the mail message of the e-mail, whereby the mail address of the user set into the mail message of the e-mail can be utilized as a destination of a reply to the e-

mail, the reply being sent from the receiving apparatus, or whereby a reply to the e-mail is returned to the mail address of the user (user's e-mail address copied into "reply-to" field (column 7, lines 36-40), enabling reply from receiving apparatus (column 7, lines 51-59)). The panel section comprises a personal computer connected to the image data communication apparatus and displaying an HTML document for storing the mail message of the user in the memory (PENTIUM®-based personal computer running on a 32-bit operating system such as Windows NT (column 3, lines 23-28)).

Lee does not disclose the transmission of image data attached to the e-mail. However, it is well known in the art that image data may be transmitted as an attachment to an e-mail message. It is common practice to transmit a document or a picture via e-mail by scanning the document or picture and attaching it to the e-mail, and in such a case the attached document is inherently converted into a format for e-mail transmission. By providing for the transmission of scanned image data as an attachment, a greater variety of image data can be transmitted for immediate reception at the receiving apparatus, and thus it would have been obvious to modify the teaching of Lee by providing a scanner for inputting image data so that the image data may be transmitted as an attachment to an e-mail message, as is well known in the art.

Regarding claims 16, 17, 20 and 21, Lee further discloses a transmitter configured to transmit an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message (column 7, lines 26-35).

Claims 22, 23, 26, 27, 28, 29, 32, 33 and 35 are method claims corresponding to above-rejected apparatus claims 1, 5, 11, 15, 16, 17, 20, 21 and 34, respectively. The

method steps are either disclosed in Lee, or would have been obvious to one of ordinary skill in the art, as set forth above.

Claims 6-10, 18, 19, 24, 25, 30 and 31 differ from the above-rejected claims in that a reply to the e-mail can be sent to the user without requiring input of the mail address of the user at the receiving apparatus. Lee discloses the sending of a reply to the user, as mentioned above, but does not explicitly state that the user is not required to input the user's mail address. This limitation is disclosed in Weber (in known prior art system, a reply attribute is automatically generated, directing a reply to the sender or originator (column 3, lines 21-27)). Thus a person receiving an e-mail message need not enter the sender's e-mail address in the "to" field when replying to a message to the sender, thereby eliminating the possibility of entering the sender's address incorrectly. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Lee by providing automatic reply attribute generation, as disclosed in Weber.

Base claims 1, 6, 11, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34 and 35 and have been amended to indicate that the mail address of the user is distinct from a mail address of the image data communication apparatus, and that a reply is returned to the mail address of the user, without being returned to the image data communication apparatus. Applicant asserts that Lee does not disclose this limitation, stating that in Lee, the sender sets a sender's e-mail address into a 'Reply-to" field, and a reply is returned to the sender that transmitted the sending e-mail (pages 15-17 of applicant's amendment).

Weber discloses a method whereby, in a third-party addressing mode, a user can specify an address, to which a reply message is transmitted from a recipient (column 3, lines 59-63; column 5, lines 4-29). This is contrary to applicant's assertion that in Weber the sender sets a sender's e-mail address into an e-mail so that reply to the original message will be directed to the sender or originator, and thus Weber discloses a conventional reply mail (pages 17-18 of applicant's amendment). If fact, Weber describes difference in operation between the conventional method (column 5, lines 4-12) and Weber's method of sending a reply message to a third party (column 5, lines 13-29).

One of ordinary skill would have recognized that a sender may want to direct responses to an e-mail message to a variety of third party recipients, as opposed to having the response directed back to him/her (Weber: column 3, lines 21-30). Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Lee by providing a means for returning a reply e-mail to an address indicated by a sender rather than to the sender, as disclosed in Weber.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 10/767,719. Although the conflicting claims are not identical, they are not patentably distinct from each other because entry of a mail address, as recited in the application, is a well-known alternative to accessing the mail address stored in a memory, as recited in the claims of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

6. Applicant's arguments filed in response to the rejections of the above claims under 35 U.S.C. 103(a) and on the grounds of nonstatutory obviousness-type double patenting as set forth in the prior Office action have been fully considered but they are not persuasive.

Regarding the rejection under 35 U.S.C. 103(a), applicant's arguments are based on the claims as amended to overcome the prior rejections. These arguments regarding the application of Lee and Weber individually to the claims (pages 15-18 of applicant's amendment) have been addressed above.

Regarding the double patenting rejection, applicant asserts that neither the claims in the present application or in the co-pending application are in their final form (page 18 of applicant's amendment). It should be noted that this rejection is provisional because the conflicting claims have not in fact been patented.

Applicant further submits that no proper evidentiary basis has been set forth for a conclusion of obviousness (page 19 of applicant's amendment). Lee discloses accessing the mail address stored in a memory (password and e-mail information associated with registered users stored in subscriber database (column 5, lines 4-6)), prior to selection of the mail address of a user stored in the memory, as recited in the co-pending application. As mentioned above, Lee also discloses a panel configured to input a mail address of a user to the image data communication apparatus, as recited in the current application (in order to log in, a user enters the e-mail address and password for authentication (column 5, lines 7-15)). Thus, Lee discloses both steps for entering mail address information. In view of the well-known status in the art of both a memory for storing mail addresses and a panel for inputting mail addresses within an image communication apparatus, it would have been obvious to provide a panel configured to input the mail address of a user, as recited in the current application, in the image communication apparatus recited in the co-pending application.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday, 7:30-5:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas D Lee
Primary Examiner
Technology Division 2625

tdl
March 31, 2006